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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,076	11/26/2003	Hiroo Okamoto	62758-066	4159
7590 09/02/2005				
MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096		EXAMINER AGWUMEZIE, CHARLES C		
		ART UNIT 3621 PAPER NUMBER		

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,076

Applicant(s)

OKAMOTO ET AL.

Examiner

Charlie C. Agwumezie

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/26/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of claims

Claims 1-20 are pending in this application per response to office action filed on June 21, 2005.

Response to Arguments

Applicant's arguments with respect to claim 1-20 have been considered but are moot in view of the new ground(s) of rejection. While it is arguable that Teruhiko teaches print control descriptor in addition to the existing technology of copy control descriptor which he disclosed as being limited to copying and not for printing thereby providing mechanism for printing as well, he does not teach away from copy control descriptor. While Teruhiko does not say that the print control descriptor and the copy control descriptor are two separate control programs, Yoneda et al provides a control information which controls both the copying and the printing (see fig. 1; 0028 and claim 16); but for the sake of clarity a new ground of rejection based on common control program have been provided.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Teruhiko European Patent Application EP 1 085 740 A2 in view of Fuchigami U.S. Patent Application Publication No. 2002/0141737 A1.

1. As per **claim 1**, Teruhiko discloses a receiving apparatus, for receiving digital information, and for outputting it into a printer, comprising:

a receiving circuit for receiving said digital information (fig. 1 and 3; col. 28, lines 35-43);

an extractor circuit for extracting static image information from said digital information (fig. 1);

a recording/reproducing circuit for recording therein the extracted static image information (fig. 8 and 10; col. 30, lines 40-45, 55+); and

an output circuit for outputting the static image information reproduced from said recording/reproducing circuit to the printer, with copy control information added thereto, as information for control of printing of said printer (0002; 0004), What Teruhiko does not explicitly teach is wherein:

said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in said printer, and printing of said digital information is controlled based upon said copy control information.

Fuchigami discloses receiving apparatus, for receiving digital information, and for outputting it into a printer, comprising:

said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in said printer, and printing of said digital information is controlled based upon said copy control information (see fig. 14 and 17; 0043; 0044; 0069; 0071; 0085; 0092; 0117; 0136; claim 27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Teruhiko and provide the said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in said printer, and printing of said digital information is controlled based upon said copy control information in view of the teachings of Fuchigami in order to show alternative method of implementation.

2. As per **claim 2**, Teruhiko discloses the receiving apparatus, further comprising: a converter circuit for converting said static image information into data for use in printing, wherein said output circuit adds the copy control information to said data for use in printing, so as to output it (fig. Fig. 9; col. 35-43, 45-50, 54-58).

3. As per **claim 3**, Teruhiko further discloses the receiving apparatus, wherein said output circuit scrambles said static image information depending upon the copy control information, so as to output it (fig. 4).

4. As per claim 4, Teruhiko further discloses the receiving apparatus, wherein said digital information is digital image information (fig. 9; col. 6, lines 54+).

5. As per claim 5, Teruhiko discloses a printer for printing digital information inputted from a recording/reproducing apparatus, comprising:

- an input circuit for inputting said digital information (fig. 1; col. 12, lines 15-22);
- a printer circuit for printing the inputted digital information (col. 2, lines 38-44);
- and a control circuit for detecting copy control information added to said digital information, thereby to perform printing in said printer circuit depending upon the detected copy control information (col. 2, lines 42-48). What Teruhiko does not explicitly teach is wherein:

- said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in said printer, and said control circuit controls printing of said digital information upon basis of copy control information detected.

Fuchigami discloses receiving apparatus, for receiving digital information, and for outputting it into a printer, comprising:

- said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in said printer, and said control circuit controls printing of said digital information upon basis of copy control information detected (see fig. 14 and 17; 0043; 0044; 0069; 0071; 0085; 0092; 0117; 0136; claim 27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Teruhiko and provide the said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in said printer, and said control circuit controls printing of said digital information upon basis of copy control information detected in view of the teachings of Fuchigami in order to show alternative method of implementation.

6. As per **claim 6**, Teruhiko discloses the printer, wherein said control circuit enables the printing when said copy control information would permit making a copy thereof in a recording/reproducing circuit, whereas the printing is disabled when said copy control information does not permit the copying thereof (fig. 2; col. 1, lines 44-50; col. 2, lines 42-48).

8. As per **claim 8**, Teruhiko discloses a printing control method, for controlling printing of digital information, comprising the following steps of:

detecting copy control information, which is added to said digital information (fig. Fig. 1 and 2; col. 2, lines 40-45); and

controlling on whether or not to permit the printing of said digital information depending upon the detected copy control information wherein printing of said digital information is controlled based upon said copy control information (fig. 2, col. 2, lines

Art Unit: 3621

40-47, col. 3, lines 1-8, col. 5, lines 1-15, col. 6, lines 15-20). What Teruhiko does not explicitly teach is wherein:

said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control.

Fuchigami discloses receiving apparatus, for receiving digital information, and for outputting it into a printer, comprising:

said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control (see fig. 14 and 17; 0043; 0044; 0069; 0071; 0085; 0092; 0117; 0136; claim 27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Teruhiko and provide the said copy control information is applicable, in common, both as information for copy control in a recording/reproducing circuit and as information for printing control in view of the teachings of Fuchigami in order to show alternative method of implementation.

9. As per **claim 9**, Teruhiko further discloses the printing control method, wherein the printing is permitted when said copy control information permits a copy in a recording/reproducing circuit, whereas printing is not permitted when the copy control information does not permit copying thereof (0004).

10. As per **claim 10**, Teruhiko further discloses the printing control method, wherein no data for use in printing is outputted when said copy control information does not

Art Unit: 3621

permit the printing (fig. 2; col. 3, lines 15-20, 40-49, col. 7, lines 30-40).

11. As per **claim 11**, Teruhiko further discloses the printing control method, further comprising informing a user that said digital information cannot be printed out, when said copy control information does not permit the printing (col. 3, lines 23-30).

12. As per **claim 12**, Teruhiko failed to explicitly disclose the printing control method, wherein transmission of print data in the printing of said digital data is conducted by "move" thereof (col. 5, lines 32-39).

13. As per **claim 13**, Teruhiko further discloses the printing control method, wherein the printing is performed when said copy control information is either one of "Copy Free", "Copy One Generation" and "No More Copy", allowing the "move", on the other hand the printing is not performed when it is "Copy Never" not allowing the "move" (col. 5, lines 32-39).

14. As per **claim 14**, Teruhiko further discloses the receiving apparatus, further comprising a temporary buffer, a print screen selecting means, and means for initiating said print screen selecting means, wherein a print screen is selected from the digital information stored in said temporary buffer for use of printing by means of said print screen selecting means (fig. 3 and 6; col. 10, lines 32-45).

15. As per **claim 15**, Teruhiko further discloses the printer, wherein said control circuit deletes the digital information stored within the printer, when the printing is completed without generating an abnormality during the printing (col. 15, lines 10-14, col. 16, lines 45-52).

16. As per **claim 16**, Teruhiko further discloses the printer, wherein said control circuit prints out the digital information stored within the printer, again, when an abnormality generates during the printing (col. 16, lines 45-52, col. 17, lines 1-5).

17. As per **claim 17**, Teruhiko further discloses the printer, further comprising a display circuit for indicating on whether the printing is completed normally or not, wherein said display circuit displays that the printing is failed when the printing is failed (col. 11, lines 12-15).

18. As per **claim 18**, Teruhiko further discloses the printer, wherein said control circuit makes setting on whether the printing should be done or not, again, depending upon a user input conducted to the input circuit, which is made responding to display by means of the display circuit (col. 5, lines 1-7, 30-39).

19. As per **claim 19**, Teruhiko further discloses the printer, wherein said control circuit informs that the printing is failed, to a digital apparatus, which outputs the print

Art Unit: 3621

data, when the printing is failed (fig. 4, col. 11, lines 12-13).

20. As per **claim 20**, Teruhiko further discloses the receiving apparatus, further comprising a display circuit for indicating a print failure message when receiving information of print failure from the printer (fig 4, col. 11, lines 12-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7, is rejected under 35 U.S.C. 103(a) as being unpatentable over Teruhiko European Patent Application EP 1 085 740 A2 and Fuchigami U.S. Patent Application Publication No. 2002/0141737 A1 as applied in claim 1, above and further in view of Yoneda et al U.S. Patent Application Publication 2002/0056115.

7. As per **claim 7**, both Teruhiko and Fuchigami failed to explicitly disclose the printer, wherein the digital information is scrambled, and said input circuit performs de-scrambling on the information inputted with scrambling thereon.

Yoneda et al discloses the printer, wherein the digital information is scrambled, and said input circuit performs de-scrambling on the information inputted with scrambling thereon (0006).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Teruhiko and provide the printer, wherein the digital information is scrambled, and said input circuit performs de-scrambling on the information inputted with scrambling thereon in view of the teachings of Yoneda et al in order to ensure that meaningful information is printed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

Art Unit: 3621

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(571) 273-8300. [Official communications; including After Final communications labeled "Box AF"].

(571) 273-8300. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

Hand delivered responses should be brought to the Examiner in the Knox Building, 50
Dulany Street Alexandria VA.

acc
August 25, 2005

**MARY D. CHEUNG
PRIMARY EXAMINER**

